UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,065	02/06/2004	Scott L Nielson		2064

22913 7590 02/01/2007

WORKMAN NYDEGGER
(F/K/A WORKMAN NYDEGGER & SEELEY)
60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111

EXAMINER	
MERCIER, MELISSA S	
ART UNIT	**PAPER NUMBER**
1615	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

TH

Office Action Summary	Application No.	Applicant(s)	
	10/708,065	NIELSON ET AL.	
	Examiner	Art Unit	
	Melissa S. Mercier	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-16 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-16 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 9-16 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim1-8. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claims 9-16 recite a "process for facilitating the detection of nail surfaces", whereas claims 1-8 recite a "method for facilitating the detection of nail surfaces". The examiner preformed a careful review of the specification and no guidance was provided for a means of ascertaining any patentable distinction between the two terms.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear to the examiner what applicant regards as preparation of the nail surface. The examiner is interpreting this to include cleaning and treating.

Claims 2 and 10 recites the limitation "the detection facilitating coating composition" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

Regarding claims 4 and 12, it is unclear to the examiner if the steps are required, since the claim comprises the proviso "however if the inspection method determines that the nail surface is correctly prepared for the coating composition, this step may be omitted". Applicant has not provided any means of ascertaining how the nail surface would be correctly prepared.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belden (US Patent 2,288,386) in view of Takami (US Patent 6,525,724).

Belden discloses a method of manicuring and articles for same. The articles comprise "a pre-formed, pre-dried finger nail or toe nail decorative coating which may be formed into desired shapes and may be readily applied by the user (column 2, lines 23-27). Belden further discloses the articles are applied by simply wetting and adhering it to a clean nail by simple pressure (column 5, lines 41-45).

Belden does not disclose digitizing the nail surface.

Takami discloses a nail ornamenting device which provides a three dimensional image of the contours and shape of a nail (abstract). Takami further discloses "a nail ornamenting device, with respect to a nail portion having its contour recognized by contour recognition device and having its unevenness recognized by unevenness recognition device, the shape or the like is displayed by three-dimensional display devices" (abstract).

It would have been obvious to a person of ordinary skill in the art to combine the teachings of Belden with the teachings of Takami in order to "enable clear printing of a desired pattern or the like on a nail surface" (Takami, abstract).

Applicant is reminded that where the general conditions of the claims are met, burden is shitted to applicant to provide a patentable distinction. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See In re Aller, 220 F.2d 454 105 USPQ 233,235 (CCPA 1955).

Furthermore the claims differ from the reference by reciting a specific thickness of the nail polish/covering. However, the preparation of nail polish/decorative compositions having various thicknesses and it is within the level of skill of one having ordinary skill in the art at the time of the invention. It has also been held that the mere selection of proportions and ranges is not patentable absent a showing of criticality. See In re Russell, 439 F.2d 1228 169 USPQ 426(CCPA 1971).

Claims 1-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser et al. (US Patent 2,449,070) in view of Takami (US Patent 6,525,724).

Hauser discloses a method of manicuring and preparation of the hands immediately preceding the application of nail polish (column 1, lines 1-3). Hauser discloses a compound is applied to the fingers just prior to putting polish on the nails which will leave a coating thereof that is substantially permanently moist and non-drying, so that even though some of the nail polish may be inadvertently brushed past its intended areas and onto such coating, no harm will be done, because upon finishing such polishing and drying, it takes only a simple whipping operation to remove said coating together with any polish adherent thereto" (column 1, lines 31-43).

Hauser does not disclose digitizing the nail surface.

Takami discloses a nail ornamenting device which provides a three dimensional image of the contours and shape of a nail (abstract). Takami further discloses "a nail ornamenting device, with respect to a nail portion having its contour recognized by contour recognition device and having its unevenness recognized by unevenness recognition device, the shape or the like is displayed by three-dimensional display devices" (abstract).

It would have been obvious to a person of ordinary skill in the art to combine the teachings of Hauser with the teachings of Takami in order to "enable clear printing of a desired pattern or the like on a nail surface" (Takami, abstract).

Applicant is reminded that where the general conditions of the claims are met, burden is shitted to applicant to provide a patentable distinction. Where the general

conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See In re Aller, 220 F.2d 454 105 USPQ 233,235 (CCPA 1955).

Furthermore the claims differ from the reference by reciting a specific thickness of the nail polish/covering. However, the preparation of nail polish/decorative compositions having various thicknesses and it is within the level of skill of one having ordinary skill in the art at the time of the invention. It has also been held that the mere selection of proportions and ranges is not patentable absent a showing of criticality. See In re Russell, 439 F.2d 1228 169 USPQ 426(CCPA 1971).

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drake et al (US Patent 3,034,965) in view of Takami (US Patent 6,525,724).

Drake discloses a composition and method for treating nails. Drake discloses a "nail base compositions adapted to be applied directly to the fingernails. The nail base is beneficial to the physical structure of the fingernail in that it counteracts the ill effects of the chemicals presenting the polish removers" (column 1, lines 22-26). The nail base is applied immediately prior to the polish (column 1, lines 34-36).

Drake does not disclose digitizing the nail surface.

Takami discloses a nail ornamenting device which provides a three dimensional image of the contours and shape of a nail (abstract). Takami further discloses "a nail ornamenting device, with respect to a nail portion having its contour recognized by contour recognition device and having its unevenness recognized by unevenness

recognition device, the shape or the like is displayed by three-dimensional display devices" (abstract).

It would have been obvious to a person of ordinary skill in the art to combine the teachings of Drake with the teachings of Takami in order to "enable clear printing of a desired pattern or the like on a nail surface" (Takami, abstract).

Applicant is reminded that where the general conditions of the claims are met, burden is shitted to applicant to provide a patentable distinction. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See In re Aller, 220 F.2d 454 105 USPQ 233,235 (CCPA 1955).

Furthermore the claims differ from the reference by reciting a specific thickness of the nail polish/covering. However, the preparation of nail polish/decorative compositions having various thicknesses and it is within the level of skill of one having ordinary skill in the art at the time of the invention. It has also been held that the mere selection of proportions and ranges is not patentable absent a showing of criticality. See In re Russell, 439 F.2d 1228 169 USPQ 426(CCPA 1971).

Claims 1-4, 7-12, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kishita et al. (US Patent 6,703,003) in view of Takami (US Patent 6,525,724).

Kishita discloses a manicure composition for nails, which was used to coat the nails (column 2, lines 52-53) after manicuring. The nails were then "evaluated by observing each dried coating on a nail with the naked eye" (column 4, lines 11-13).

Kishita does not disclose digitizing the nail surface.

Takami discloses a nail ornamenting device which provides a three dimensional image of the contours and shape of a nail (abstract). Takami further discloses "a nail ornamenting device, with respect to a nail portion having its contour recognized by contour recognition device and having its unevenness recognized by unevenness recognition device, the shape or the like is displayed by three-dimensional display devices" (abstract).

It would have been obvious to a person of ordinary skill in the art to combine the teachings of Kishita with the teachings of Takami in order to "enable clear printing of a desired pattern or the like on a nail surface" (Takami, abstract).

Conclusion

No claims are allowable. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MSMercier

LS Kishore

Lailamudi S. Kishore, PhD
Primary Examiner
Group 1600